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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/608,798	06/26/2003	Brett M. Debenham	2831.6US (96-0202.06/US)	6863
24247	7590	12/02/2005	EXAMINER	
TRASK BRITT P.O. BOX 2550 SALT LAKE CITY, UT 84110			CHUNG, PHUNG M	
			ART UNIT	PAPER NUMBER
			2138	

DATE MAILED: 12/02/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/608,798	DEBENHAM, BRETT M.	
	<b>Examiner</b>	<b>Art Unit</b>	
	Phung My Chung	2138	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-22 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/26/03</u> . | 6) <input type="checkbox"/> Other: ____.  |

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1. Claims 1-22 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 1, lines 9-11, "decision circuitry for receiving...for considering the at least one type of failure of the identified types of failures in one of for designating the at least one semiconductor..." is not clear as to what it meant.

As per claim 20, line 14, "the re-identified types" should be changed to

- - the re-identified types - -.

As per claims 2-19 and 21-22, these claims are also rejected because they dependent upon the rejected base claim.

### **Double Patenting**

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. A nonstatutory obviousness-type double patenting rejection is appropriate where the conflicting claims are not identical, but at least one examined application claim is not patentably distinct from the reference claim(s) because the examined application claim is either anticipated by, or would have been obvious over, the reference claim(s). See, e.g., *In re Berg*, 140 F.3d 1428, 46 USPQ2d 1226 (Fed. Cir. 1998); *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) or 1.321(d) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent either is shown to be commonly owned with this application, or claims an invention made as a result of activities undertaken within the scope of a joint research agreement.

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims a) 1-16 and 18-22

b) 1-4, 6-16 and 18-22

c) 1-16 and 18-22

d) 1-22

e) 1-22

f) 1-22

are rejected under the judicially created doctrine of obviousness type double  
patenting as being unpatentable over claims

a) 1, 4-7, 9, 11-25, 27-28, 30, 32, 36 and 38

b) 1, 4-7, 9, 13-25, 27-28, 30, 32-36 and 38

c) 1, 4-7, 9, 11-25, 27-28, 30, 32-35, 37 and 39

d) 1-6, 8-23, 25-26, 28, 30, 32-37 and 39

e) 1, 3-6, 8-23, 25-26, 28, 30, 32-37 and 39

f) 1, 3-20, 22-23, 25, 27, 29, 31-36, 39 and 41

of U. S. Patent No.

a) 6,587,980

b) 6,523,144

c) 6,321,353

d) 6,219,810

e) 6,138,256

f) 5,764,650

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Although, the conflicting claims are not identical, they are not patentably distinct from each other because all of the limitation of the rejected claims contain similar limitations as recited in a) 1, 4-7, 9, 11-25, 27-28, 30, 32, 36 and 38

b) 1, 4-7, 9, 13-25, 27-28, 30, 32-36 and 38

c) 1, 4-7, 9, 11-25, 27-28, 30, 32-35, 37 and 39

d) 1-6, 8-23, 25-26, 28, 30, 32-37 and 39

e) 1, 3-6, 8-23, 25-26, 28, 30, 32-37 and 39

f) 1, 3-20, 22-23, 25, 27, 29, 31-36, 39 and 41

of U. S. Patent No.

a) 6,587,980

b) 6,523,144

c) 6,321,353

d) 6,219,810

e) 6,138,256

f) 5,764,650

and there is no reason why the rejected claims could not have been presented in the patents.

The following is an example table shows the claims in 10/608,798 that are rejected by corresponding claims in patent 6,587,980.

#### Claims Comparison Table

**10/608,798**

**6,587,980**

1

1

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2	4
3	5
4	6
5	11, 12
6	13
7	14
8	15
9	16
10	17
11	18
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14	21
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18	25
19	27, 28
20	7
21	9
22	30

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4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Phung My Chung whose telephone number is 571-272-3818. The examiner can normally be reached on Monday to Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Albert Decady can be reached on 571-272-3819. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Phung My Chung  
Primary Patent Examiner  
Art Unit 2138